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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/643,047 | 08/18/2003 | Dennis K. Fisher | ADO 0101 PA | 3107 |
| 7590 | 04/13/2006 | | EXAMINER | |
| DINSMORE & SHOHL LLP Suite 500 One Dayton Centre Dayton, OH 45402-2023 | | | LEE, RIP A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1713 | |

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/643,047 | FISHER, DENNIS K. | |
| | Examiner Rip A. Lee | Art Unit 1713 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 and 14 is/are rejected.
- 7) Claim(s) 13 is/are objected to.
- 8) Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11-20-2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on January 30, 2006. Claims 1-25 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a hot melt pressure sensitive adhesive, classified in class 428, subclass 355R.
 - II. Claims 15-25, drawn to a roofing membrane, classified in class 52, subclass 409.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a road marking composition and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Susan M. Luna on April 6, 2006, a provisional election was made with traverse to prosecute the invention of group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-25 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1, 4, 5, and 7-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-10 of copending Application No. 10/935,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Present claim is drawn to a hot melt pressure sensitive adhesive comprising: (a) a rubbery copolymer comprising a blend of (i) from about 10 to about 25 wt % of thermoplastic block copolymer selected from the group consisting of SBS, SIS, SEBS, SEPS, EP, and combinations thereof, and (ii) from about 5 to about 20 wt % of polyisobutylene, (b) tackifier, and (c) an amorphous polyolefin.

Claim 2 of the copending application is drawn to a hot melt pressure sensitive adhesive comprising: (a) a rubbery copolymer comprising a blend of (i) thermoplastic block copolymer selected from the group consisting of SBS, SIS, SEBS, SEPS, EP, and combinations thereof, and (ii) polyisobutylene, (b) tackifier, and (c) an amorphous polyolefin.

The claims of the instant application are anticipated by, or obvious over, the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Terminal Disclaimer

9. The terminal disclaimer filed on January 30, 2006, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,794,449 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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13. Claims 1, 3, 4, 7, 8, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt (U.S. 6,482,281).

Schmidt discloses a hot melt adhesive comprising up to 15 wt % of thermoplastic elastomer, 15-55 wt % of polyisobutylene, 5-40 wt % of poly- α -olefin, 5-45 wt % of tackifier, filler, and stabilizers (claim 1). Example 3 shows a composition comprising 9.3 wt % of SEBS block copolymer, 11.1 wt % of Oppanol B10 polyisobutylene, STATAc 80 aliphatic resin with aromatic groups, amorphous poly(propylene/1-butene) copolymer, Oppanol B100 polyisobutylene plasticizer, and CaCO₃ reinforcing filler. It is maintained that the amount of SEBS, 9.3 wt %, reads on the recited “about 10 wt %” lower bound of the claimed range.

14. Claims 2, 5, 6, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt.

The examples in Schmidt do not disclose a composition in which the amount of thermoplastic lies in the range of about 10-15 wt %. However, one of ordinary skill in the art would have found it obvious to arrive at the claimed range because Schmidt teaches that the amount of thermoplastic may be as high as 15 wt %. One of skill in the art would have sufficient motivation to use about 10-15 wt % of thermoplastic especially in view of Example 1, which shows a formulation containing 10 wt % of SEBS block copolymer. The formulation in Example 3 contains CaCO₃ as filler rather than silica. However, one of ordinary skill in the art would have found it obvious to use silica because Schmidt also teaches that this is a useful filler (col. 7, line 40). Use of butyl rubber is not shown in Example 3, but one of ordinary skill in the art would have found it obvious to include butyl rubber in the composition because Schmidt instructs that rheological properties of the adhesive may be optimized by use of butyl rubber (col. 7, lines 21-29). One of ordinary skill in the art would have found it obvious to use butyl rubber to achieve the appropriate cold flexibility property of the adhesive especially in light of the fact that Schmidt shows such a practice in the formulations of Example 1 and 2. The subject matter of claim 9 is obvious over Schmidt since butyl rubber is essentially polybutene in constitution (col. 7, line 23). One of skill in the art also would have found it obvious to use amorphous polypropylene homopolymer in lieu of the amorphous poly(propylene/1-butene) copolymer

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because Schmidt shows that this type of amorphous polyolefin is suitable for inventive adhesive compositions (examples 1 and 2). The subject matter of claim 12 is obvious over the teachings of Schmidt because the patent teaches that phosphites may be incorporated into the adhesive formulation. One of skill in the art would have found it obvious to include phosphites and thereby confer flame retardant properties to the adhesive because such a teaching lies in the disclosure of Schmidt.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt in view of Ardegmani (U.S. 4,072,735).

Schmidt does not teach use of a release liner for the particular application of the invention. Ardegmani shows that similar hot melt adhesive compositions have various end uses, one of which is an adhesive strip is protected by a release liner. When the adhesive is needed, the release liner is removed and two surfaces may be adhered by the adhesive (col. 3, lines 42-52). One of ordinary skill in the art, having both references at hand, would have found it obvious to use the adhesive of Schmidt with a release liner as shown in Ardegmani in order to protect the adhesive until its use is required.

16. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Schmidt does not teach or fairly suggest use of the compounds recited in the claim.

Response to Arguments

17. The provisional obviousness type double patenting rejection has been withdrawn due to Applicant's filing of a terminal disclaimer. The rejection of claims under 35 U.S.C. 102(e) over Fisher (U.S. 6,794,449) is improper, and therefore, the rejection has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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April 6, 2006



DAVID W. WU
ADVISORY PATENT EXAMINER
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